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09/501,793	02/10/2000	Rob G. Parrish	P30321US	4384

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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 07/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/501,793

Applicant(s)

Rob G. Parrish

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on May 24, 2002

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 59-74 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 59-74 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on Sep 30, 1999 is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on May 24, 2002 is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

6) Other: _____

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DETAILED ACTION

Acknowledgments

1. The amendment filed May 24, 2002 (Paper No. 18) is acknowledged. Accordingly, claims 59-74 remain pending.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

a. The “receiving portion” as recited in claim 63.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. No new matter allowed. The following must be shown or the features canceled from the claims:

a. The “means for limiting reciprocation” as recited in claim 60.
b. The “receiving portion” as recited in claim 63.

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A proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

c. The Examiner notes the claims are replete with the above drawing errors. All structural elements recited in claims 59-74 are clearly not shown in the drawings. The Examiner highly recommends Applicant review all 16 claims to ensure that every method step recited is shown in the drawings. To show no new matter is found in the drawings, the Examiner respectfully requests Applicant to explicitly show where in the specification Applicant has support or antecedent basis for any new drawings or drawing changes. Additionally, a proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

d. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “22” has been used to designate both a “receptacle (page 9, line 13) and “a mounting portion receptacle” (page 6, line 13). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

e. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on May 24, 2002 (Paper No. 15) have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new

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matter into the disclosure of an application. The original disclosure does not support the showing of “a wall of immovable structure.”

Claim Rejections - 35 USC § 112 1st Paragraph

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 63 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not known what is the “receiving portion.”

6. Claims 59-74 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. “[A] wall of immovable structure” is considered new matter. If Applicant can expressly point out where in the original specification the description is found, the 35 U.S.C. 112, 1st paragraph rejection will be withdrawn. The Examiner notes the specification provides disclosure for a wall but not one “of immovable structure.”

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Claim Rejections - 35 USC § 112 2nd Paragraph

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

8. Claims 59-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The claims are replete with errors. Some examples follow.

a. In claims 59, 63, and 68, it is unclear whether the Applicant is claiming the subcombination of an apparatus or the combination of an apparatus and a wall.

If the Applicant's intent is to claim only the subcombination, the body of the claim(s) must be amended to remove any positive recitation of the combination. If the Applicant intends to claim the combination, the preamble of the claim must be amended to be consistent with the language in the body of the claim.

If Applicant expressly states on the record that the claim is drawn to the combination, the rejection will be withdrawn.¹ As the claim currently stands, it appears to be drawn to the subcombination making the wall outside the scope of the claims.

b. In claim 63, it is unclear what structural elements make up the "receiving portion."

¹ The Examiner notes however that this may result in a restriction between the combination and subcombinations.

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c. In claim 73, it is unclear whether the Applicant is claiming the subcombination of an apparatus or the combination of an apparatus and a vehicle storage compartment.

If the Applicant's intent is to claim only the subcombination, the body of the claim(s) must be amended to remove any positive recitation of the combination. If the Applicant intends to claim the combination, the preamble of the claim must be amended to be consistent with the language in the body of the claim.

If Applicant expressly states on the record that the claim is drawn to the combination, the rejection will be withdrawn.² As the claim currently stands, it appears to be drawn to the subcombination making the vehicle storage compartment outside the scope of the claims.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the Applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

² The Examiner notes however that this may result in a restriction between the combination and subcombinations.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the Applicant for patent.

10. Claims 59 and 60, as understood by the Examiner, are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Deerman (U.S. Des. 419,505). See figure 2.

11. Claims 61 and 62, as understood by the Examiner, are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Deerman with Klemstsen (U.S. 5,476,279).³ It is the Examiner's principle position that a block and friction member are inherent in the embodiment shown in Deerman figure 2 since the holes are present for the block. Klemstsen is used only to show precisely what the block and friction member would look like.

12. Claims 59-74, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hull et. al. (U.S. 4,938,399).

13. Claims 59-74, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 102(b) as being clearly anticipated by Franciso (U.S. 4,991,865).

14. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

³ See MPEP §2131.01 expressly authorizing a multiple reference §102 rejection where the question of inherency arises.

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15. Functional recitation(s) using the word “for” (e.g. “for converting a trailer hitch apparatus to a temporary storage device mounted to a wall”) have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).⁴

16. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicant to be his own lexicographer and define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001)(“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002)

⁴ When interpreting functional language, if the prior art is capable of performing the claimed function—even if not directly disclosed—it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (Applicant’s popcorn dispenser was rejected with an oil can because the functional limitations were inherent in the reference).

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(There is a “heavy presumption that a claim term carries its ordinary and customary meaning.”).

See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).⁵

However, if Applicant does desire any claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicant(s) in their next response to expressly indicate the claim limitation at issue⁶ and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one

⁵ It is the Examiner’s position that “plain meaning” and “ordinary and accustom meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustom meaning . . .”).

⁶ “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

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reasonably skilled in the art on notice that the patentee intended to so redefine the claim term").⁷

The Examiner cautions that no new matter is allowed.

Failure by Applicant in his next response to address this issue or to be non-response to this issue entirely will be considered a desire by Applicant to give all claim limitations their ordinary and accustom meaning. The claims are then interpreted with their "broadest reasonable interpretation" *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁸ Applicant is cautioned that even though claim interpretation begins with this presumption, any interpretation disclaimed during prosecution may still further limit that claim

⁷ See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), ("[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]"); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) ("Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention."). See also MPEP §2111.02, subsection titled "Applicant May Be Own Lexicographer" and MPEP §2173.05(a) titled "New Terminology."

⁸ See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

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element. See *Pall Corp. v. PTI Technologies Inc.*, 259 F.3d 1383, 59 USPQ2d 1763, 1769 (Fed. Cir. 2001).

17. Although Applicant uses “means for” in the claims (e.g. claim “means for limiting reciprocation”), it is the Examiner’s position that the “means for” phrases do not invoke 35 U.S.C. 112 6th paragraph. If Applicant concurs, the Examiner respectfully requests Applicant to either amend the claims to remove all instances of “means for” from the claims, or to explicitly state on the record why 35 U.S.C. 112 6th paragraph should not be invoked.

Alternatively, if Applicant desires to invoke 35 U.S.C. 112 6th paragraph, the Examiner respectfully requests Applicant to expressly state his desire on the record. Upon receiving such express invocation of 35 U.S.C. 112 6th paragraph, the “means for” phrases will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6¶*.⁹

Failure by Applicant to address the 35 U.S.C. 112 6th paragraph issues in the manner set forth above or to be non-response to this issue entirely will be considered a desire by Applicant NOT to invoke 35 U.S.C. 112 6th paragraph.

⁹ Federal Register Vol 65, No 120, June 21, 2000.

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Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 61 and 62, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Deerman in view of Klemstsen.¹⁰ It is the Examiner's principle position that Deerman and Klemstsen anticipate the claimed invention since the block is inherent in Deerman. However, if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deerman as taught by Klemstsen to include a block. This would prevented Deerman's apparatus from falling off.

Response to Arguments

20. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

¹⁰ See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

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21. It is the Examiner position that because Applicant has claimed “an apparatus” in claims 59, 63, and 73, the “trailer hitch apparatus” and the “temporary storage device” are not part of the claimed invention.

22. It is the Examiner position that because Applicant has claimed “a device” in claim 68, the “trailer hitch apparatus” and the “temporary storage device” are not part of the claimed invention.

23. The Examiner maintains and concurs with Applicant’s position that the species are not patentably distinct. See Applicant’s response, January 22, 2001 (Paper No. 4), page 3 where Applicant states “Because the inventions are not patentably distinct, Applicant contends the restriction requirement is improper.” The Examiner continues to rely on this statement.

24. Since Applicant did not seasonably traverse the Official Notice statement(s) as stated in the previous Office Action (Paper No. 7, paragraph No. 12), the well known statement(s) are taken to be admitted prior art. See MPEP §2144.03 and *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

Conclusion

25. Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

26. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

27. The art unit and technology center for this application has changed. The new art unit is 3627 in technology center 3600. So that papers may be properly matched, please indicate the new art unit on any paper submitted with this application.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.

AJ Fischer
ANDREW J. FISCHER
PATENT EXAMINER
7/24/02

AJF
July 22, 2002

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